I.　　Preliminary Matter

Applicant respectfully requests that the Examiner clarify the references made of record

but not considered pertinent to Applicant's disclosure listed on page 8 of the Office Action. In

particular, US Patent No. 6,091,903 does not correspond to Miller et al. and US Publication No.

2003/0050916 does not correspond to Bortscheller et al.

II.　　Claim Rejections under 35 U.S.C. § 103

Claims 1-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over

McGraw-Hill Primisu Custom Publishing (www.mhhe.com/primis), archived circa 1998, via the

Wayback Machine (www.archive.org).

The Examiner asserts that the collection of modular, stand-alone text files stored in the

Primis database of McGraw, teaches the second plurality of content entities in a data repository,

as recited in claim 1. However, claim 1 recites "A method for adding content to a *first content*

object stored as a *first plurality of content entities* in a *data repository*, the data repository

containing *a second plurality of content entities* of *a second content object*, each of the content

entities having an identifier..." The Examiner has failed to establish where a first content object

stored as a first plurality of content entities is stored in the Primis database (data repository as

cited by the Examiner).

In particular, the Primis database appears to at most store the collection of modular,

stand-alone files (second plurality of content entities), however, there is no indication that

another plurality of content entities of a first content object (custom book as cited by the

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Examiner) is also stored in the Primis database. Moreover, it is unclear where the customized book of McGraw is stored once it is built, however, it does not appear to be stored in the Primis database. Although McGraw teaches a method for creating a custom published textbook, there is no evidence of such a book in the McGraw reference. In particular, page 3 of McGraw merely describes "What is Primis Database Publishing?" and refers to the creation of a customized textbook without any evidence of the customized textbook itself.

Claim 1 further recites "defining the *first object* by *a first list of content entity identifiers*, such that adding the *content entity identifier* of one of the *second plurality of content entities* to the *first list* adds the identified content entity to the *first object*."

Applicant respectfully submits that there is no indication that the customized book (first object) is defined by a first list of content entity identifiers. In particular, there is no illustration in the McGraw reference as to what elements define a customized book. Further, there is no indication of the addition of a content entity identifier of one of the *second plurality of content entities* to a *first list*.

The Examiner asserts that it was commonly known to those of ordinary skill in the art that an "Add" hyperlink corresponding to each second object identifier exists for the purpose of adding the content entities of a second object to a first object. Further, the Examiner reasons that

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it was commonly known to those of ordinary skill in the art that a "Review"[1] hyperlink exists

for the purpose of reviewing the contents of the first object in an outline form.

Applicant submits that the Examiner's reasoning regarding the functions of the "Add"

and "Review" hyperlink being commonly known to those of ordinary skill at the time is

inappropriate. In particular, the Examiner has provided no evidence, other than his own personal

reasoning, that the functions of the "Add" and "Review" hyperlink were commonly known.

Also, it appears that the "View" hyperlink is for the purpose of viewing content of a particular

book (second plurality of content entities as cited by the Examiner) in the database and is not for

reviewing the contents of a customized book.

A conclusory statement by the Examiner that a claimed element is well known in the art

without any support or reasoning, is insufficient to establish an obviousness rejection. Further,

the Examiner's personal reasoning is insufficient to establish an obvious rejection. MPEP 2143.

"To support the conclusion that the claimed invention is directed to obvious subject matter,

either the references must expressly or impliedly suggest the claimed invention or the examiner

must present a *convincing line of reasoning* as to why the artisan would have found the claimed

invention to be obvious in light of the teachings of the references." Merely stating that a

claimed element is commonly known and would be obvious to one of ordinary skill in the art is

not a convincing line of reasoning.

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[1] The Examiner refers to a "Review" hyperlink, however, Applicant was unable to locate a "Review" hyperlink. It appears the Examiner is referring to the "View" hyperlink.
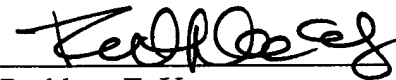
For at least the above reasons, claim 1 and its dependent claims should be deemed patentable. Since claims 6, 16, 21, 31 and 36 recite similar elements, claims 6, 16, 21, 31 and 36 and their dependent claims should be deemed patentable for the same reasons.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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